



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/412,404	10/05/1999	JOSHUA D. KAPLAN	106.48	9614

7590 04/19/2002

MICHAEL E DERGOSITS  
DERGOSITS & NOAH LLP  
FOUR EMBARCADERO CENTER  
SUITE 1150  
SAN FRANCISCO, CA 94111

EXAMINER

FADOK, MARK A

ART UNIT PAPER NUMBER

2165

DATE MAILED: 04/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

# Office Action Summary

Application No.

09/412,404

Applicant(s)

KAPLAN, JOSHUA D.

Examiner

Mark A Fadok

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed Feb. 22, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: d) a tracking process that tracks the user's progress through the network website.

Applicant is required to cancel the new matter in the reply to this Office Action.

The Examiner is in receipt of applicant's amendment dated 2/22/2002, received at the office on 4/2/2002. The 112 rejection has been removed and the receipt of the terminal disclaimer has removed the 101 rejection.

### ***Response to Arguments***

The arguments presented by the applicant have been reviewed, but are moot in view of the following rejection.

### ***Specification***

The disclosure is objected to because of the following informalities: The claimed subject matter "between 3 and 8 discrete rating selections" is shown in FIG 4, but not described in the specification.

Appropriate correction is required.

### ***Claim Objections***

Claims 53, 56, 59, and 65 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The word music as used in said claims does not further limit the invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39,43, 44, 61,62,64, and 65 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification teaches the use of the invention with music and video, but fails to describe its use with regard to written works.

Claims 26-37,44,46-51 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In steps c, d and e, a process is claimed.

Art Unit: 2165

Thus it is unclear if applicant is claiming methods steps, or further limiting the article as set forth in the preamble. Applicant is required to restrict the claim to one of an article or a method.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 26-38, 44-51, 56-60, 64-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble states the claim is directed to a network website. A network website is an HTML document that contains files, documents and graphics that are generally available in cyberspace through the World Wide Web. The claims refer to items that could not exist in a website, for instance, a central host server could contain a web site, however, a website cannot contain a server.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 21-41, 43-51,53,56,59,62,64, and 65 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Bernard (5,918,213).**

In regards to claims 21-41, 43-51,53,56,59,62,64, and 65, Bernard teaches all the limitations cited in the subject claims, For example, Bernard discloses An automated product purchasing system allows purchasers to order products via a remote communications medium without having to speak to a sales representative or other human operator. According to the invention, purchasers access the automated product purchasing system and browse among the selections offered. Menu style prompts guide the customer through the various products offered by the automated product purchasing system. Product descriptions are provided to assist the customer in making his or her selections. Where appropriate, product samples are provided to the customer via the communications medium so the customer can evaluate the product prior to purchasing. Examples of product samples include movie previews; sample cuts from music tracks, software demos, and the like. Ordering and purchasing are automated so that human operators are not required to intervene in the process. The use of a membership profile with important customer information facilitates the automation of the process and minimizes the amount of times a repeat customer needs to provide this information (abstract).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 42 rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Bernard, and further in view of Koz et al (6,188,428).**

In regards to claim 42, Bernard teaches memory storage devices (col. 19, lines 43-49), but does not specifically state RAID. KOZ . teaches a random access data storage system subsystem **78** that includes a "Redundant Array of inexpensive Disks" (RAID (col. 8, lines 54-58). It would be obvious to a person of ordinary skill in the art to included in Bernard a Raid array drive as taught by Koz, because if one memory device were to be down the other could supplant it and provide uninterrupted data).

**Claims 42 rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Bernard, and further in view of Miller et al (5,842,199).**

In regards to claims 52,54,55,57,58,60,61,63,and 66, Bernard teaches the collection of customer profile information which is used to determine preferences (from which interest in a product can be determined and scored; col. 3, lines 63-67 and col. 4, lines 1-7), but does not specifically mention rating a product using between 3 and 8 discrete rating selections, displayed graphically on a computer display. Miller teaches that explicit rating methods in collaborative filtering systems are single keystrokes entered by users. The keystrokes usually represent values along a single ordered dimension, discretized for ease-of-entry. Miller does not limit the number of discrete

rating selection and therefore could include between 3 and 8 selections. It would be obvious to a person of ordinary skill in the art to include in Bernard the rating method as taught by Miller, because the ratings can provide value to a web site by providing visitors information that may reduce the time needed to make a purchase.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Fadok whose telephone number is (703) 605-4252. The examiner can normally be reached on Monday to Thursday 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Mark Fadok  
April 15, 2002



WYNN COGGINS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100